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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,654	02/01/2006	Georges Moineau	284854US0PCT	7532
22850 7590 12/20/2010 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER COONEY, JOHN M				
ART UNIT		PAPER NUMBER		
1765				
NOTIFICATION DATE		DELIVERY MODE		
12/20/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/566,654

Applicant(s)

MOINEAU ET AL.

Examiner

John Cooney

Art Unit

1765

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-18 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-18 and 20-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4-12-10 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 11, 12 and 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maruyama et al.(4,264,743) in view of Bley's(5,521,226).

Maruyama et al. discloses preparations of flexible polyurethane foams prepared by mixing a hydrophobic polyol as claimed, an isocyanate, and blowing agent including water and passing the foam to a location to allow for it to foam, crosslink, and cure to products having densities as claimed and having good permeability and waterproofing properties under compression which are seen to meet the ranges of compression

property values defined by applicants' claims (see column 4 line 17 – column 10 line 50, Examples, and claims).

Maruyama et al. differs from applicants' claims in that it does not specifically require NCO Index values as claimed by applicants' claims. However, the reference specifically identifies preferred values for approaching the Index values of applicants' claims and identifies benefits and weaknesses, respectively, associated with operating within and beyond the preferred ranges of the instant claims (column 8 lines 24-32). Accordingly, it would have been obvious for one having ordinary skill in the art to have operated at ratios of Index values below the preferred ratios of Maruyama et al.'s disclosure if one were not interested in the good contact angle with water afforded to products having fuller reaction of available hydroxyl groups for the purpose of obtaining acceptable products having residual hydroxyl functionality in order to arrive at the products and processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results. Further, it has long been held that where the general conditions of the claims are disclosed in the prior art, discovering the optimal or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233; *In re Reese* 129 USPQ 402 . Further, a prima facie case of obviousness has been held to exist where the proportions of a reference are close enough to those of the claims to lead to an expectation of the same properties. *Titanium Metals v Banner* 227 USPQ 773. **(see also MPEP 2144.05 I)**. Similarly, it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272,205 USPQ 215 (CCPA 1980). Additionally, it should be noted

that all disclosures of the prior art, including unpreferred or auxiliary embodiments, must be considered in determining obviousness. In re Mills, 176 USPQ; In re Lamberti, 192 USPQ 278; In re Boe, 148 USPQ 507.

Maruyama et al. differs from applicants' claims in that it does not require the isocyanate components having make-ups as now claimed. However, Bleys discloses mixtures of MDI isomers containing 2,4'-isomer in amounts in overlap with those of applicants' claims for purposes of providing acceptable isocyanate reactant material in an advantageous liquid state in polyurethane foam forming mixtures. Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the isocyanates of Bleys as the isocyanates in the preparations of Maruyama et al. for the purpose of providing acceptable isocyanate reactant material in an advantageous liquid state in order to arrive at the products and processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

Claims 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maruyama et al.(4,264,743) in view of Bleys(5,521,226) as applied to claims 1-9, 11, 12 and 20-25 above, and further in view of Peterson et al.(4,386,166).

Although Maruyama et al. discloses manufacture of films in its disclosure, it differs from applicants' claims in that it does not exemplify the casting and laminating the mixtures of its disclosure to films on conveyor belts passing through ovens.

However, Peterson et al. discloses the making of urethane foam composite articles through the casting and laminating of mixtures to films on conveyor belts passing through ovens (see abstract & column 9 line 39-column 10 line 20). Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the composite article forming processes of Peterson et al. in the foam manufacturing processes of Maruyama et al. for the purpose of making acceptable reinforced articles in order to arrive at the products and processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

Applicant's arguments with respect to claims 1-9, 11-18 and 20-25 have been considered but are moot in view of the new ground(s) of rejection.

The following previous arguments are maintained as they are still applicable to the new ground(s) of rejection set forth above:

Applicants' arguments have been considered. However, rejection is maintained. The discrepancies between the Index values of applicants' claims and those of Maruyama et al. are maintained to be properly addressed in the rejection above, and have not been refuted by applicants' reply. Applicants' have not attached criticality to the Index values of their claims. A sufficient showing of new or unexpected results attributable to this difference in the claims that is commensurate in scope with the scope of the claims and demonstrated to be more significant than the expected results of record has not been made and is not seen to be evident.

Difference is not seen between the material make-up of the preparations of applicants' claims and those of Marayuma et al. beyond the differences indicated in the rejection above. It is not seen, nor is it made evident, that difference in applicants' claims based on the compression values of the claims may be attributed to difference in any material feature of the preparations of the claims, including the Index values of the claims. Further, even if the compression values were to be associated with the Index values of the claims, these results would necessarily need to be demonstrated to be more significant than the results of record that would be expected from such a change.

Based on the evidence of record including physical data that is provided for by Maruyama et al., it is not seen that difference based on the range of compression force values of applicants' claims over what is provided for by the teachings and fair suggestions of Maruyama et al., alone, or in combination with Peterson et al. is evident.

The Office is not in a position to run experiments to verify that the ranges of compression force values possessed by the preparations of Maruyama et al. and/or that would result from making the changes to Index values indicated in the rejection above. It is held and maintained that that burden is appropriately shifted to applicants. Applicants' statement that comparative 1 represents Maruyama et al. is not seen to sufficiently meet applicants' burden of showing new or unexpected results attributable to differences in applicants' claims that are commensurate in scope with applicants' claims. First, it is not seen or demonstrated how this comparison represents the teaching of Maruyama et al. Second, even if it were demonstrated to represent an embodiment of Maruyama et al., it is not seen or made evident that this single showing is representative of what is taught or fairly suggested by the full teaching of Maruyama et al. or is sufficient in satisfying the requirement that applicants' showing be commensurate in scope with the scope of applicants' claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/John Cooney/
Primary Examiner, Art Unit 1796